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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/313,131	05/17/1999	ERAN STEINBERG	4473-27	3485

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SAWYER LAW GROUP LLP  
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PALO ALTO, CA 94303

EXAMINER
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NGUYEN, LUONG TRUNG

ART UNIT	PAPER NUMBER
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2612

DATE MAILED: 12/23/2003

24

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/313,131

Applicant(s)

STEINBERG, ERAN

Examiner

LUONG T NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,11,17-21,30 and 53-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,11,17-21,30 and 53-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 21.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments with respect to claims 1, 3-5, 11, 17-21, 30 and 53-59 filed on 9/03/2003 have been considered but are moot in view of the new ground(s) of rejection.

In re pages 10-11, Applicant argues that the claims of the present invention are directed to an integrated digital camera apparatus that includes an image capture apparatus, transceiver apparatus, automatic signal transmission apparatus, and code apparatus, all in one housing, as recited in claim 1. Such an integrated digital camera is not taught by the combination since Reeley, the primary reference, clearly teaches a separate camera and cell phone.

In response, the Examiner disagrees. Even though, Figure 2 of Reeley et al. shows the cellular telephone 28 as being a separate unit from the camera 10, Reeley still discloses such an integrated digital camera apparatus because Reeley et al. disclose that the two separate units (camera 10 and cellular telephone 28) may be readily combined within a single housing as an integrated module (column 4, lines 49-51).

In re page 11, Applicant argues that the combination of references fail to teach or suggest "sorting the messages into categories based on individual users and categories of users; and transmitting from said message center to the camera, messages that match the categories associated with the user" as recited in claim 53. Itakura teaches retrieving messages based on user information, but is silent as to grouping messages by category.

In response, regarding claim 53, it is noted that the feature "grouping messages by category" is not recited in claim 53. Claim 53 only recited the limitation "sorting the messages

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into categories based on individual users and categories of users; and transmitting from said message center to the camera, messages that match the categories associated with the user.” This feature is disclosed in Itakura. Itakura et al. disclose sorting the messages into categories based on individual users and categories of users (message ID is searched based on the user’s characteristics, Column 3, Lines 32-52, Column 5, Lines 50-60); and transmitting from said message center to the camera, messages that match the categories associated with the user (transmitting messages to terminal 10, Column 8, Lines 1-25).

In re page 11, Applicant argues that there is no teaching or suggestion supporting the combination.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-5, 11, 17-21, 30 are rejected under 35 USC 103(a) as being unpatentable over

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Reele et al. (U.S. 5,893,037) in view of Ilcisin et al. (US 5,880,770) further in view of Itakura et al. (US 6,351,745) and Hawkes (US 6,161,122).

Regarding claim 1, Reele et al. disclose an integrated digital camera apparatus comprising a housing (See Figure 2, column 4, lines 49-51); a digital image acquisition apparatus (camera unit 10, Figure 2, column 4, lines 47-51) built into the housing, the digital image acquisition apparatus including image capture apparatus for converting a light image to digital image data (image sensor 44, Figure 3, column 3, lines 15-20); a messaging apparatus independent of said digital image acquisition apparatus (cellular phone 28, Figure 2, column 4, lines 47-51) built into the housing, said messaging apparatus including a transceiver apparatus (transmitter/receiver circuit 54, Figures 4-5, column 3, lines 64-67 ) limited to sending and receiving messages through a communication network (See Figure 4, column 3, line 64 through column 4, line 31), said messages not including digital image data from said digital image acquisition apparatus (Figures 3-5, Column 3, line 64 through Column 4, Line 46); and a code apparatus for selectively receiving messages sent to the transceiver by a message center from a service provider (see Column 5, Lines 25-35 and note that a code is present in the form of dialing the appropriate phone number); message display apparatus for communicating said messages to a user of said camera apparatus in graphic form or audio form (display 30, Figure 4, Column 4, Lines 15-20).

Reele et al. do not disclose an automatic signal transmission apparatus for automatically causing the transceiver to transmit a message request signal to the message apparatus conveying an identification of the camera apparatus when the transceiver is turned on. However it is well known in the art to operate a videophone system in such a manner, as disclosed in Ilcisin et al. in

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order to make sure that necessary messages are received by the person initiating the call (See Column 2, Line 49 through Column 3, Line 12 and note that a camera's identification is inherently conveyed in the initiation of a call from the particular apparatus with which the camera is associated). Such a provision for the Reelee et al. device would clearly increase its utility by increasing the kinds of information available to the users of the videophone network. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide in the Reelee et al. device an automatic signal transmission means for automatically causing the transceiver to transmit a message request signal to the message center conveying an identification of the camera when the transceiver is turned on in order to increase the utility of the device by increasing the kinds of information made available to the user.

Reelee et al. and Ilcisin et al. fail to specifically disclose wherein said messages include advertisements, and wherein said service provider includes any combination of a billing center, a retailer, and a camera manufacturer; and whereby said messaging apparatus in said camera apparatus and said message center allows said service provide to promote an ongoing business relationship with said user after sale of said camera apparatus. However, Itakura et al. disclose a communication system for distributing such message as advertisement to user of terminal equipment, in which in the pay system 35 (billing center), the message distribution apparatus 39 (message center) transmits messages regarding goods, such as advertisement to the network including terminal 10 (Figure 1, Column 7, line 50 through Column 8, Line 25). In addition, Itakura et al. also disclose that the user may access the communication network to buy goods (such as "ski suit", goods may be camera), and the system provider can reliably provide update information to users (Column 25, Lines 45-65, service provide to promote an ongoing business

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relationship with said user after sale of said camera apparatus). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in Reeley et al. and Ilcisin et al. by the teaching of Itakura et al. in order to allow users find advertisements for goods or services, which match their interests, and advertisers can efficiently provide messages to potential users who have a high probability of purchasing their goods (Column 3, Lines 48-52).

Reeley et al., Ilcisin et al. and Itakura fail to specifically disclose wherein said messages include at least one of warranty registration forms; and questionnaires. However, Hawkes discloses a method and apparatus for providing messages at multiple sites, in which messages might be warranty (column 7, lines 30-33). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in Reeley et al., Ilcisin et al. and Itakura by the teaching of Hawkes et al. in order to enable the device have the capability to transmit different type of messages.

Regarding claim 3, Ilcisin et al. disclose a user activated apparatus for causing the transceiver to transmit a message request signal to the message center conveying an identification of the camera (See Column 2, Lines 49-56).

Regarding claim 4, Reeley et al. disclose all of the limitations except apparatus disabling the automatic signal transmission apparatus when a user does not want to receive messages. However it is well known in the art to operate a videophone system so as to send messages automatically, as disclosed in Ilcisin et al. in order to make sure that necessary messages are

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received by the person initiating the call (Column 2, Line 49 - Column 3, Lines 12). Such a provision for the Reeley et al. device would clearly increase its utility by increasing the kinds of information made available to the users of the videophone network. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide in the Reeley et al. device an automatic signal transmission apparatus for automatically causing the transceiver to transmit a message request signal to the message center conveying an identification of the camera when the camera is turned on in order to increase the utility of the device by increasing the kinds of information made available to the user. In Ilcisin et al. this feature may be disabled when the user does not want to receive messages (See Column 3, Lines 65-67 and note that longer-time-period messages may not be acceptable).

Regarding claim 5, Reeley et al. are silent regarding a model number of the camera and therefore do not disclose that the code apparatus includes identification of a model number of the camera. However it is common practice in the art to form a videophone device using a camera that is separately manufactured, such as the AT&T 2500 disclosed in Ilcisin et al. (See Column 4, Lines 29-31 of Ilcisin et al. and page 25 of AT&T Technical Journal where the camera is said to be separately manufactured by Sony), the camera clearly having a model number given thereto by its manufacturer. In view of the teaching in Ilcisin et al., it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a separately manufactured camera for the Reeley et al. device since it is well known in the art to so form videophone devices. In such an arrangement the code apparatus would clearly include identification of a model number of the camera since in order for there to be proper reception and display of pictures the



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model number of the camera used in the manufacture of the sending integrated digital camera apparatus must be the same as that of the receiving integrated digital camera apparatus. The ability to receive, process and display meaningful pictures from a sending camera identifies it having the same model as that of the integrated digital camera apparatus for such a specific videophone network.

Regarding claim 11, Ilcisin et al. disclose an interactive message response apparatus for responding to a question received in a message from the message center (Column 7, lines 40-45).

As for claim 17, all the limitations are contained in claim 1, therefore, see Examiner's comments regarding claim 1, except for the feature a message center including apparatus for collecting, preparing and sorting messages to be sent to a transceiver in an assembly including a digital camera which is disclosed in Ilcisin et al. (Column 2, Line 49 through Column 3, Line 33; Column 8, Lines 13-35) and a first communication apparatus responsive to reception of a message request signal conveying a camera identification for transmitting messages to the transceiver (Ilcisin et al., See Column 2, Lines 49-56 and note that the calling device's camera identification is inherently provided in the initiation of a call from a particular apparatus with which it is associated).

Regarding claim 18, Ilcisin et al. disclose that the message center includes a capability to send a selected message to a specific integrated hand held assembly based on the code (Column 2, Lines 49-52).

Regarding claim 19, Ilcisin et al. disclose that the message center further includes a capability to send a message simultaneously to a plurality of integrated hand held assemblies by transmitting a corresponding particular code (Column 8, Lines 13-35).

Regarding claim 20, Ilcisin et al. disclose that the message center further includes a capability to prioritize messages as part of a single packet of multiple messages (Column 8, Lines 13-35).

Regarding claim 21, Ilcisin et al. disclose that the integrated hand held assembly further includes means for disabling the automatic signal transmission apparatus (Column 1, Lines 60-61).

Regarding claim 30, Ilcisin et al. disclose an interactive message response apparatus for responding to a question received in a message from the message center (Column 7, Lines 40-45).

4. Claims 53-59 are rejected under 35 USC 103(a) as being unpatentable over Itakura et al. (U.S. 6,351,745) in view of Hawkes (US 6,161,122) further in view of Maurinus et al. (US 5,606,365).

Regarding claims 53-55, Itakura et al. disclose a communication system for distributing such message as advertisement to user of terminal equipment, comprising the steps of providing a message center (message manager 24, Figure 1) for storing messages that include

advertisements (Column 8, Lines 1-11); sorting messages in to categories based on individual users and categories of users (message ID is searched based on the user's characteristics, Column 3, Lines 32-52, Column 5, Lines 50-60); transmitting messages that match the categories associated with the user (transmitting messages to terminal 10, Column 8, Lines 1-25), such that the messages are communicated to the user in graphical or display form (display means for displaying the message transmitted to the terminal, Column 5, Lines 40-45), thereby providing the service provider with an opportunity to promote an ongoing business relationship with the user (the user may access the communication network to buy goods (such as "ski suit"), and the system provider can reliably provide update information to users, Column 25, Lines 45-65).

Itakura fail to specifically disclose wherein said messages include at least one of warranty registration forms; and questionnaires. However, Hawkes discloses a method and apparatus for providing messages at multiple sites, in which messages might be warranty (column 7, lines 30-33). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in Itakura by the teaching of Hawkes et al. in order to enable the device have the capability to transmit different type of messages.

Itakura et al. and Hawkes fail to specifically disclose maintaining records of camera users and corresponding camera identification; and transmitting messages from the message center to the camera. However, Itakura et al. disclose the user may access the communication network to buy goods (such as "ski suit", goods may be a camera, Column 6, Lines 20-25) and Maurinus et al. disclose interactive camera for network in which the camera manufacture 48 downloads the correction codes with the camera ID to the headen computer 52 (message center) and transmits to the user HIC 54, which comprises camera 10 (Figure 2, Column 9, Lines 20-35, Column 7,

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Lines 9-30). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in Itakura et al. and Hawkes by the teaching of Maurinus et al. in order to allow user to follow up the update of camera.

Regarding claim 56, Itakura et al. disclose wherein the user can subscribe with the message center to receive messages for selected categories (the users can find advertisements for goods, which match their interests, Column 3, Lines 48-50).

Regarding claim 57, Itakura et al. disclose wherein the user may select an option from the camera not to receive any messages (a detector detects when user is inactive, see abstract)

Regarding claim 58, Maurinus et al. disclose the message center continuously transmits generic messages to a plurality cameras (plurality cameras 10, 10', 10'', Figures 2, 4b).

Regarding claim 59, Itakura et al. and Maurinus et al. disclose the message center packages personal messages for the user and for the particular camera model together with generic messages, and transmit the package to the camera (Column 5, Lines 38-67).

### ***Conclusion***

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5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Luong Nguyen** whose telephone number is **(703) 308-9297**. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wendy Garber**, can be reach on **(703) 305-4929**.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 872 - 9314

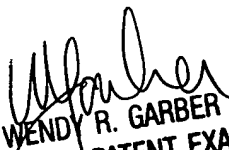
Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal drive,

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Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

LN  
12/13/03

  
WENDY R. GARBER  
SUPERVISORY PATENT EXAMINER  
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